

## REMARKS

Reconsideration and allowance of the present patent application based on the following remarks are respectfully requested.

By this Response, no claims are amended, added or cancelled. Accordingly, after entry of this Response, claims 1-9 and 11-23 will remain pending in the instant application.

Claims 1-3, 6-9, 11-13, 16-19 and 21-23 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. The rejection is respectfully traversed.

In connection with this rejection, the Office Action indicates that the term “‘unitary display panel’ may [be] consider[ed] as the new subject matter since there is no disclosure of ‘unitary display’ in the original description.” This assertion is factually and legally incorrect.

First, it is respectfully submitted that the Office has failed to carry the initial burden of establishing a reasonable basis to question the written description of the claimed invention. Applicant respectfully submits that “[t]he examiner has the initial burden of presenting by a **preponderance of evidence** why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims.” See MPEP §2163(III)(a) citing Wertheim, 541 F.2d at 263, 191 USPQ at 97 (emphasis added). The methodology for determining adequacy of the written description involves (a) determining, for each claim, what the claim as a whole covers, (b) reviewing the entire application to understand how Applicant provides support for the claimed invention including each element and/or step and (c) determining whether there is sufficient written description to inform a skilled artisan that Applicant was in possession of the claimed invention as a whole at the time the application was filed. See MPEP §2163(II). “In rejecting a claim, **the examiner must set forth express findings of fact regarding the above analysis** which support the lack of written description conclusion.” MPEP §2163(III)(a) (emphasis added). Here, the Office has provided no finding of facts whatsoever regarding the above analysis. Nor has the Office presented any evidence or reason as to why a person skilled in the art would not recognize that the written description in the specification provides support for the claimed inventions. Rather, the Office merely alleges that “there is no disclosure of ‘unitary display panel’ in the original specification.” This is clearly inadequate at law.

Second, the fundamental inquiry for determining compliance with the written description requirement is not whether the specification recites *verbatim* each and every

feature of a claim, as suggested by the Office; rather, as noted above, it is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. “In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide an *in haec verba* support for the claimed subject matter at issue.” Purdue Pharma L.P. v. Faulding Inc., 56 USPQ2d 1481 (Fed. Cir. 2000), citing Fujikawa v. Wattanasin, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996). See also MPEP §2173.05(e) (“[t]here is no requirement that the words in the claim ***must match*** those used in the specification disclosure” and “Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.”) Furthermore, “[a]n applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as ***words, structures, figures, diagrams*** and formulas that fully set forth the claimed invention.” See MPEP §2163(I) citing Lockwood, 107 F.3d at 1572, 41 USPQ2d at 1966 (emphasis added). Thus, the underlying determination in the Office Action that a claim necessarily fails to comply with the written description requirement of 35 U.S.C. §112, first paragraph, simply because a claim term is not used ***verbatim*** in the detailed description is incorrect at law and not in line with the Office’s own rules and policies.

Third, Applicant draws the Office’s attention to FIG. 1 of the present application where a unitary display panel is clearly shown, as recited in the claims. FIG. 1, shows a single panel 10, i.e. a unitary display panel, that is divided into a first area 11 and a second area 12. The Office’s attention is also drawn to the accompanying description in paragraph 16 of the present patent application where it is stated, “*a display apparatus 100 includes a panel 10, which has a first area 11 and a second area 12. The first area 11 is configured to display first data 21. The second area 12 is configured to display second data 22.*” Paragraph 25 of the present patent application further states, “*the panel 10 has two areas, [but] the number of the display areas defined in a panel is not limited to 2.*” These descriptions clearly convey to those skilled in the art that the panel 10 is **not** a combination of different panels (like, e.g. panels 10 and 20 in Uchida (US 7019714)), but a unitary panel with two or more areas defined thereon. The mode of operation of the unitary display panel 10 is described for example, at paragraph 24 of the present patent application, which discloses different illumination modes of the panel 10. These modes include a first mode (standby mode) where the first light source 31 is in ON state and the second light source 32 is in OFF state, so only

the first area 11 of the panel 10 shows information; and a second mode where both the first light source 31 and the second light source 32 are in ON state, so the first area 11 and the second area 12 together display complicated information.

Accordingly, for at least these reasons, Applicant respectfully submits that claims 1-3, 6-9, 11-13, 16-19 and 21-23 fully comply with the written description requirement and are patentable.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-3, 6-9, 11-13, 16-19 and 21-23 under 35 U.S.C. §112, first paragraph, are respectfully requested.

Claims 1-3, 11-13 and 21-23 are rejected under 35 U.S.C. §102(e) based on U.S. 7,019,714 to Uchida *et al.* (hereinafter "Uchida"). This rejection is respectfully traversed.

Claim 1 recites a display apparatus selectively operated in a first mode and a second mode, said display apparatus comprising, *inter alia*, "a unitary display panel having a viewer side and a back side, said viewer side divided into a first area and a second area, in response to an image signal, said first area and said second area configured to display variable data on said viewer side." The cited portions of Uchida do not disclose, teach or suggest these aspects of claim 1.

In response to Applicant's Amendment of December 26, 2007, the Office continues to interpret the panel of claim 1 as being the combination of two panels and deliberately ignores the added recitation "unitary display panel" on the ground that this recitation constitutes new subject matter. However, as clearly explained above, the original disclosure fully supports the recitation "unitary display panel". As a result, Applicant respectfully requests the Office to consider this limitation.

With this said, and as abundantly explained in the December 26<sup>th</sup> Amendment, the cited portions of Uchida clearly fail to disclose, teach or suggest the above identified aspects of claim 1. Specifically, the cited portions of Uchida fail to disclose, teach or suggest the use of a unitary display panel having a viewer side and a back side, said viewer side divided into a first area and a second area. Rather, the cited portions of Uchida disclose two separate displays - EL panel 10 and LCD panel 20. *See*, Uchida at FIGS. 4 and 5, and col.6, lines 55-61 "[t]he mobile terminal electronic apparatus (portable telephone) 200 of the present embodiment has a built in a mobile terminal telephone apparatus body 201, an organic EL display (organic EL panel) 10 that has a full color active matrix display, and a transfective liquid crystal display device (liquid crystal panel) 20 that is a full color active matrix display." As such, the cited portions of Uchida not only fail to teach a *unitary display panel* having a

viewer side and a back side, as required by the claims, but indeed teach away from such a limitation.

Furthermore, for at least the same reasons as provided in the December 26<sup>th</sup> Amendment, Applicant respectfully submits that Uchida fails to teach *a first light source for illuminating said first area from said back side*, as required by the claims. In addition, as explained in the December 26<sup>th</sup> Amendment, the cited portions of Uchida disclose that LCD panel 20 needs inorganic LED or organic EL backlight for illumination. *See* Uchida at col. 5, lines 38-41. While LCD panel 20 has a backlight while EL 10 does not, Uchida clearly fails to teach how to achieve the *substantially same visual brightness on the viewer side* for both, as also required by the claims.

Further, Applicant strenuously disagrees with various assertions made in the Office Action. For example, the Office asserts that “said first area and said second area are illuminated with inherently substantially same brightness by said first light source and said second light source simultaneously.” *See* Office Action at page 3, emphasis added. This assertion is not supported by facts. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). *See* MPEP 2112. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). *See* MPEP 2112, Emphasis added. Further, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art.” (*See* MPEP § 2112 citing *Ex Parte Levy*, 17 U.S.P.Q. 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). *See* MPEP 2112, Emphasis added. Here, the Office has not provided any evidence whatsoever to support the determination that it is inherent that the first area and the second area of Uchida are illuminated with substantially the same brightness by the first light source and the second light source simultaneously. There simply is none. Accordingly, Applicant respectfully submits that the Office’s reliance on the theory of inherency is improper.

Accordingly, for at least these reasons, Applicant respectfully submits that claim 1 is patentable over the cited portions of Uchida.

Claims 2-3 are patentable over the cited portions of Uchida at least by virtue of their dependency from claim 1 and for the additional features recited therein.

Claim 1 is patentable over the cited portions of Uchida for at least similar reasons as provided above for claim 1 and for the features recited therein. For example, claim 1 is patentable over the cited portions of Uchida at least because this claim recites a display system, comprising, *inter alia*, “a unitary display panel having a viewer side and a back side, said viewer side divided into a first area and a second area, in response to an image signal, said first area and said second area configured to display variable data on said viewer side.”

Claims 12-13 are patentable over the cited portions of Uchida at least by virtue of their dependency from claim 11 and for the additional features recited therein.

Claim 21 is patentable over the cited portions of Uchida for at least similar reasons as provided above for claim 1 and for the features recited therein. For example, claim 21 is patentable over the cited portions of Uchida at least because this claim recites a mobile device selectively operated in a first mode and a second mode, said mobile device comprising, *inter alia*, “a unitary display panel having a viewer side and a back side, said viewer side being divided into a first area and a second area, in response to an image signal, said first area and said second area being configured to display variable data on said viewer side.”

Claims 22 and 23 are patentable over the cited portions of Uchida at least by virtue of their dependency from claim 21 and for the additional features recited therein.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-3, 11-13 and 21-23 under 35 U.S.C. §102(e) based on Uchida are respectfully requested.

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. A Notice to that effect is respectfully requested.

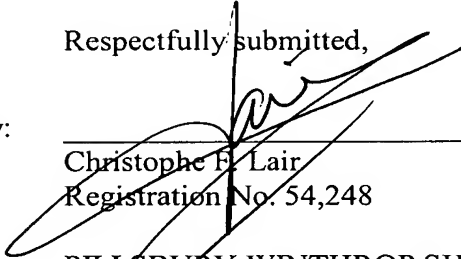
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

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By:

Respectfully submitted,

  
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